

Remarks:

This is a full and complete response to the Office action dated December 23, 2008. Favorable reconsideration of the claims is respectfully requested.

REGARDING THE CLAIMS:

Claims 1-3, 6, 8-10, 13, 18-19 are pending in the application. Claim 1 and 9 have been amended and claims 20-21 have been canceled. No new matter has been added.

PRIORITY

The Examiner has objected to the claim of priority of the present application to US 09/347,531 ('531) arguing that support for the claims is not found therein. Applicants respectfully disagree.

In the Office Action, the Examiner objects to the mol% of unsaturated fatty acid recited in claim 1. Applicants have amended claim 1 to remove this feature from claim 1 and also canceled claims 20-21. Accordingly, Examiner's objection is moot in this respect.

The Examiner also argues that the limitation "without substantially reducing $\Delta 6$ -desaturase activity without substantially reducing the $\Delta 6$ -desaturase activity of the polypeptide" is not supported in the '531 application. The Examiner argues that the '531 application does not disclose any nucleic acid sequences encoding $\Delta 6$ -desaturase other than sequence Fig. 1 and so does not teach or suggest "variants with substantially the same activity." Applicants respectfully submit that the Office Action is applying an overly restrictive standard with respect to support.

Applicants note that under 35 USC §120, the claims in a U.S. application are entitled to the benefit of the filing date of an earlier filed US application if the subject matter of the claim is disclosed in a manner provided by 35 USC §112, first paragraph in the earlier filed application. *MPEP §2163.03 (II)*. Accordingly, if the earlier filed application conveys with reasonable clarity to those skilled in the art that as of the filing date sought, the inventor was in possession of the claimed invention then the support requirement according to 35 USC §112, first paragraph is satisfied.

Additionally, Applicants note that according to *Capon*, the determination of what is needed to support generic claims to biological subject matter depends on a variety of factors, such as (1) the existing knowledge in the particular field, (2) the extent and content of the prior art, (3) the maturity of the science or technology, (4) the predictability of the aspect at issue, and (5) other considerations appropriate to the subject matter. *Capon v. Eshar*, 418 F.3d 1349, 1358, 76 USPQ.2d 1078 (Fed. Cir. Aug 12, 2005).

Accordingly, it would be clear to one of ordinary skill in view of the ‘531 application that Applicants had possession of the claimed invention at the time of filing. In light of the disclosure of the ‘531 application it would be clear to those of skill in the art that variants the activity of a polypeptide having a very narrow homology of only “at least 95%” would not have a substantial reduction in activity. The technology and state of the art was such that support is clearly shown.

For example, as stated in the ‘531 application, “change in the amino acid sequence can be easily produced by known methods of genetic engineering e.g. site directed mutagenesis.” From this statement it can be understood that deletions and substitutions to change the amino acid sequence is well known in the art and could be accomplished easily by those of skill in the art. Furthermore, when such substitutions are made, the ‘531 application states: “the biological activity (delta6 desaturase) can be checked by known assays e.g. those disclosed in this invention.” Therefore, not only are the substitutions well known, but the application also notes that activity of the peptide can also be checked. Furthermore, the inference is clear that the reason for checking the biological activity is to assure that the activity of peptide has not significantly changed, i.e. that the activity is not substantially reduced and/or at the very least to assure there is still delta6 desaturase activity.

Therefore, Applicants submit that support for the recited limitation “still having $\Delta 6$ -desaturase activity” in claim 1 and “without substantially reducing the $\Delta 6$ -desaturase activity of the polypeptide” in claim 9 are supported in the ‘531 application and satisfy the requirements of 35 USC §112, first paragraph. Accordingly, Applicants respectfully request the above mentioned objection to priority be withdrawn.

PRIORITY – DE 100 30 976.2

The Examiner objected to foreign priority stating that the translated copy was not filed together with a statement that the translation of the certified copy is accurate. Applicants respectfully submit that pending client documentation, the requisite documentation will be provided.

IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 102:

Claims 1-3, 8-9, and 13 stand rejected under 35 USC §102(b) as being anticipated by **Girke et al.**, Plant J., July 27 1998, Vol. 15 (“**Girke**”). Applicants respectfully traverse this rejection. Claims 6 and 10 stand rejected under 35 USC §103(a) as being unpatentable over **Girke** in view of Napier et al., Curr. Opin. Plant Bio. Apr., 1999 2:123-127 (“**Napier**”). Applicants respectfully traverse these rejections.

As noted above, support for the presently amended claims can be found in the ‘531 application. Accordingly, priority of the present claims extends to the filing of the ‘531 application, namely July 6, 1999. As the **Girke** reference was not published more than 1 year before the priority date of the present application, Applicants respectfully note that the above rejection under 35 USC §102(b) is inapplicable. Additionally, and for similar reasons, the **Girke** reference cannot be used as a basis for rejection under 35 USC §103. Accordingly, Applicants request the above mentioned rejections be withdrawn.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-3, 6, 8, 18, 20 and 21 stand rejected under 35 USC §112, first paragraph, for failing to comply with the written description requirement.

The Examiner asserted that claims 1 and 20-21 recite a process for preparing an unsaturated fatty acid in a cultured fungus or yeast wherein the cultured organism contains from 1 to 80% or from 1 to 60% or from 1 to 40% of unsaturated fatty acid based on the total fatty acid content in the organism. Applicants have amended claim 1 to remove “1 to 80 mol% of unsaturated fatty acid” and canceled claims 20-21

accordingly the rejection is now moot. Accordingly, Applicants respectfully request the above mentioned rejection be withdrawn.

In view of the comments above, it is respectfully requested that the rejections be withdrawn and a Notice of Allowance issue with respect to the currently pending claims.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: BASF 0093/000032.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

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Respectfully submitted,

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